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IN THE

Supreme Court of the United States

OCTOBER TERM, 1971

No. 71-54

MOORE BUSINESS FORMS, INC., *Petitioner,*

v.

UARCO INCORPORATED, *Respondent.*

PETITION FOR REHEARING OF DENIAL OF PETITION FOR CERTIORARI

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PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

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This petition respectfully seeks rehearing by this Court of the petition for writ of certiorari to the United States Court of Appeals for the Seventh Circuit filed herein. The petition was denied on October 12, 1971, with the notation that Justices Douglas and Blackmun would grant the petition. An important new fact has just come to petitioner's attention. Also in all candor, petitioner understands that a "rule of three" is now in effect because only seven Justices are presently sitting. Petitioner earnestly seeks the concurrence of one additional Justice that the petition be granted.

The new fact of which petitioner has just been apprised since October 12, 1971, is this: still another

declaratory judgment action has been filed with respect to the Uarco patent which the Chief Judge of the District Court for the Northern District of Illinois found invalid but the Court of Appeals held valid.

In brief, on March 30, 1971, the Seventh Circuit Court of Appeals held the patent in suit valid. This petition followed. It has just been learned that on June 3, 1971, an action seeking, *inter alia*, a declaration that the same Uarco patent is invalid was filed in the District Court for the Southern District of New York under 71 Civ. 2500. It is entitled *Transkrit Corp.* v. *Uarco Inc.* As previously noted, on June 15, 1971, Civil Action No. 36658, *Perry Printing Co.* v. *Uarco Inc.*, was filed in the District Court for the Eastern District of Michigan. It also seeks a declaration that the same Uarco patent is invalid. Both declaratory judgment actions were filed more than two months after the Seventh Circuit's holding that the Uarco patent is valid; in both cases the complaint alleged as a basis of invalidity that the subject matter of the patent is obvious under 35 U.S.C. § 103.

It is apparent that, recognizing the startling difference in interpreting "obviousness" by the pro-patent Seventh Circuit, and the Second and Sixth Circuits, which have much less regard for patents, plaintiffs believe that the Uarco patent will not be held valid in the Second and Sixth Circuits. Incidentally, plaintiffs in both declaratory judgment actions are represented by esteemed and respected patent firms, which apparently believe the Seventh Circuit will not be followed.*

* Transkrit Corp. is represented by Kenyon & Kenyon, Reilly, Carr and Chapin, New York, N. Y. Perry Printing Co is represented by Harness, Dickey & Pierce, Detroit, Michigan.

Thus, there is a strong likelihood that the reverse of *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation*, 402 U.S. (No. 338-October Term, 1970; decided May 3, 1971), will be presented to this Court at some time in the future. This will not help the present petitioner, who will be the only party in the United States that will have been compelled to pay tribute to the Uarco patent. Is now not the time to determine the validity of the Uarco patent without having lower courts burdened with who knows how many other actions to declare the Uarco patent invalid?

The filing of the two declaratory judgment actions is evidence that the patent bar, as much as litigants, requires guidance on the issue of obviousness under 35 U.S.C. § 103. While most Courts of Appeals are in substantial uniformity in their treatment of other issues, e.g., public use and on sale (35 U.S.C. § 102(b)), it is concerning obviousness or invention that they differ so widely, from the highly pro-patent Seventh Circuit to the highly anti-patent Eighth Circuit. Is it fair to the patent bar and litigants to have that most common issue, obviousness, turn on a race to the Courthouse? Yet if this Supreme Court does not review decisions on obviousness—hopefully once a term—how can a patent attorney advise his client with any degree of certitude? There is no record of how much needless litigation has flooded the courts, and patent litigation consumes huge amounts of court time disproportionate to the mere number of actions, simply because patent counsel cannot make a reasonable guess on what will happen to the issue of obviousness, depending on where the action is brought.

Certainly this Court's time must be devoted to other matters of greater importance to this country, but can

it not spare time for one patent decision per term on the issue of obviousness? This should be that case, because the subject matter is as simple as a roll of perforated stamps. In view of the extreme differences among the circuits, the patent bar and those concerned with patents urgently need this Court's ultimate supervision.

Respectfully submitted,

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CERTIFICATE OF COUNSEL

I hereby certify that this petition for rehearing is based on the discovery by petitioner of *Transkrit Corp.* v. *Uarco Inc.*, not known to counsel for petitioner until after the denial of certiorari by this Court on October 12, 1971.

JAMES H. MARSH, JR.